Election/Restrictions

1. Applicant's election with traverse of Group II, claims 32-39 in the reply filed on 10/22/2007 is acknowledged. The traversal is on the ground(s) that the search for group I would include a search of the invention embodied in Group II. This is not found persuasive because the search of Group I does not require a search in the same areas as a search for Group II, they are classified into a different class, 264 vs. 428.

   The requirement is still deemed proper and is therefore made FINAL.

2. Applicant is reminded of their right to request rejoinder of method claims with the product claims upon indication of the product claims as being allowable. The method claims must be commensurate with the allowed article claims, i.e. have been amended to recite all the features of the allowed article claims. See *In re Ochiai* 37 USPQ2d 1127.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

   The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 39 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear as to what is meant by a joint opening. Does Applicant want to convey that the two openings are aligned in a thickness direction to form a through hole. As such, it should be incorporated into the claim for purpose of clarity.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 32, 33, 35 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2 216 081. GB teaches an automotive acoustic insulation panel assembly comprising a heavy layer 11 and a sound attenuation layer 14 connected to the heavy layer as shown in figure 11. The sound attenuation layer is made of a polyurethane foam (page 2). The heavy layer adjoins the sound attenuation layer parallel to its contours and without any gap. The heavy layer is made of rubber material which is a thermoplastic elastomer (page 4). The circumference of the sound attenuation layer reaches beyond the circumference of the heavy layer (page 10). The heavy layer comprises regions of different thickness (page 5). Likewise, it is clearly apparent that the sound attenuation layer comprises regions of different compression so as to conform to the surface of the heavy layer. GB'081 does not specifically disclose a strand placement process. However, it is a product-by-process limitation not as yet shown to produce a patentably distinct article. It is the examiner's position that the article of GB'081 is identical to or only slightly different than the claimed article prepared by the method of the claim, because

both articles are formed from the same materials, having structural similarity. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi,* 218 USPQ 289,291 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with GB'081. GB'081 does not specifically disclose the foam layer spot-welded to the heavy layer. However, such would have been recognized by one skilled in the art to eliminate the movement of the foam layer in relation to the heavy layer, thereby providing good dimensional stability of the insulation panel assembly. As such, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the foam layer welded to the heavy layer at some locations along their interface motivated by the desire to eliminate

the movement of the foam layer in relation to the heavy layer, thereby providing good dimensional stability of the insulation panel assembly.

7. Claims 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2 216 081 as applied to claim 1, further in view of WO 01/76914. US 6,951,263 to Blomeling et al will be relied on as an equivalent form of WO 01/76914. GB'081 does not specifically disclose the sound attenuation layer is an open cell foam material. Blomeling, however, teaches a sound absorber wherein the foam layer is an open cell foam material or a non-woven coated foam material (abstract, column 5, lines 20-21). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use an open cell foam material or a non-woven coated foam material as a sound attenuating layer motivated by the desire to provide excellent acoustic properties.

8. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2 216 081 as applied to claim 1, further in view of Kliwer et al (US 6,228,478). GB'081 does not specifically disclose the foam layer having a compression hardness of no less than 4kPa and a permanent set ranging from 3 to 6%. Kliwer, however, teaches a foam material suitable for sound insulation purposes in vehicles having a compression hardness greater than 4 kpa (table 1). Since the permanent deformation is directly related to the compression hardness, it is not seen that the permanent deformation could be outside the claimed range. Therefore, it would have

been obvious to one having ordinary skill in the art at the time the invention was made to use the foam material having a compression hardness as taught by Kliwer motivated by the desire to provide excellent acoustic properties.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 32-39 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/565,307. Although the conflicting claims are not identical, they are not patentably distinct from each other

because the claims of 10/565,307 fully encompass the claimed subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on Monday through Thursday, from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HV

/Hai Vo/
Primary Examiner, Art Unit 1794